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1 RECORD OF ORAL HEARING
2
3 UNITED STATES PATENT AND TRADEMARK OFFICE
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5
6 BEFORE THE BOARD OF PATENT APPEALS
7 AND INTERFERENCES
8

9
10 *Ex parte* FHITA LANZENDORFER, FRANZ STAB
11 and SVEN UNTIEDT
12

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14 Appeal 2008-4227
15 Application 08/849,525
16 Technology Center 1617
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19 Oral Hearing Held: November 5, 2008
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23 Before DONALD ADAMS, RICHARD LEOVITZ and MELANIE
24 MCCOLLUM, *Administrative Patent Judges*.
25

26 ON BEHALF OF THE APPELLANTS:
27

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33 *The above-entitled matter came on for hearing on Wednesday,*
34 *November 5, 2008, commencing at 1:58 p.m., at the U.S. Patent and*
35 *Trademark Office, 600 Dulany Street, Alexandria, Virginia.*

PROCEEDINGS

JUDGE ADAMS: Good afternoon Mr. Muensterer. We're familiar with your record and you will have 20 minutes. If you wouldn't mind beginning by spelling your name into the record we would appreciate it.

MR. MUENSTERER: It's MUENSTERER. Like Munster cheese but with an extra er on the end.

JUDGE ADAMS: Okay.

MR. MUENSTERER: I would like to first address the rejection over Evans in view of Suzuki. I've read the rejection many, many times and I think I know now where the examiner may have been misled by the references. What Evans clearly teaches is that antioxidants are known for use in cosmetic compositions but they are known only as is stated in column 1 starting at line 38, "however the CTFA handbook describes the purpose of these antioxidants as follows:" -- these antioxidants are mentioned in the preceding passage namely ascorbic/erythorbic acids and related compounds, tocopherols, BHA, BHT, hydroquinone and other synthetic compounds. So what the handbook says, "antioxidants are ingredients employed in cosmetics to prevent or retard spoilage from rancidity (or deterioration from reaction with oxygen). Antioxidants play a vital role in maintaining the quality, integrity and safety of cosmetic products. Hence the use of antioxidants in cosmetic products as generally practiced is targeted at maintaining the stability of the cosmetic ingredients themselves." And then the crucial passage, "clearly it is desirable to provide antioxidants in skin care products for the control of peroxidation in the skin tissue itself." So that's the whole purpose of these antioxidants that are mentioned in Evans. Finding an antioxidant that is not just for protecting the components of a

1 cosmetic composition from oxidation, but to also protect the lipids in the
2 skin from oxidation. That's apparently the invention. They found several
3 compounds that they managed to isolate in pure form that really can protect
4 not just components of cosmetic compositions, but the skin itself from
5 oxidation. These are carnosic acid, carnosol and sodium carnosate. These
6 are the compounds the isolation of which is described in Evans. So the
7 examiner now says -- and that's what I never quite understood, since Evans
8 already teaches that, then it's obvious to use any other antioxidant in these
9 compositions of Evans especially the ones that are disclosed in Suzuki,
10 because Suzuki also mentions inhibition or suppressing of formation of
11 lipoperoxides by these glycosol rutin compounds. That never really made
12 much sense to me. And today I read the examiners answer again and it
13 occurred to me that she apparently misread the passages at columns 3 and 4
14 of Evans. I have to admit it's easy to not right away understand what these
15 passages really mean because they start out, for example in column 3 line 50
16 they talk about, "generally the antioxidant compound is dissolved in a
17 suitable solvent." In the next paragraph, "the antioxidant compound may
18 also be added directly to an existing cosmetic product." Or, "two or more
19 antioxidant compounds may be added to a skincare product." Or, "it has
20 been found convenient to encapsulate an antioxidant compound in a
21 liposome." Or, "for skincare use the total amount of antioxidant that may be
22 effective may vary from --" and so on. Several more passages of Evans talk
23 about antioxidants, and apparently that's where the examiner got it wrong.
24 The examiner from her comments apparently construed this to mean that all
25 these passages here that I just mentioned and additional ones that talk about
26 the antioxidants, talk about antioxidants in general. But that is clearly not the

1 case. Whenever Evans talks about the antioxidant or the antioxidants, in
2 columns 3 and 4, what is meant is the specific compounds -- carnasol,
3 carnosic acid and derivatives and salts thereof -- that they have described
4 and isolated. It's not antioxidants in general. But the examiner clearly
5 believes that this is just a general description of what antioxidants can do.

6 JUDGE ADAMS: Sure.

7 MR. MUENSTERER: And by the way, that would not make sense.
8 Because, why even bother? There are so many antioxidants. Why would
9 you want to isolate one of these very specific ones, if there are other
10 antioxidants that would serve the same purpose? But the examiner, for
11 example, in the examiners answer in the last paragraph of page 6 says,
12 "accordingly it is considered that one of ordinary skill in the art at the time
13 the invention was made would have found it obvious to provide the glycosol
14 rutin of Suzuki et al in the skin treatment method of Evans et al because
15 Evans et al teaches antioxidants can be applied to skin to control oxidative
16 damage from a UVB radiation such as sunburn --

17 JUDGE MCCOLLUM: In the interest of time, could we possibly
18 discuss the combination if you don't interpret it the way you're now saying?
19 If you interpret Evans to mean the antioxidants of Evans and talk about the
20 combination with that interpretation, I think that might be -- whether the
21 combination is proper even if the examiner didn't interpret it the way you're
22 saying she did.

23 JUDGE ADAMS: For example --

24 MR. MUENSTERER: Yeah.

25 JUDGE ADAMS: If Evans talks about compositions, for example
26 sunscreens or sun lotions, and Suzuki talks about compositions, for example

1 sun lotions or sunscreens, and both say that in such compositions it's
2 important to have antioxidants in them particularly to negate the effect of
3 UVB radiation, and then from those two references that both say in those
4 types of compositions you want an antioxidant to have that affect, why
5 wouldn't you combine the antioxidants? I understand what you're saying
6 about the particular antioxidants disclosed by Evans and why would one
7 necessarily go out and discover and use a brand new one when there are
8 others that are out there. But the combination of Evans and Suzuki are those
9 two known antioxidants. It's known.

10 MR. MUENSTERER: Well why not use the antioxidant that
11 expressly is already mentioned in Evans? Evans mentions several examples
12 as I've pointed out before like
13 ascorbic/erythorbic acids and related compounds, tocopherols, BHA, BHT,
14 and hydroquinone. But Evans says they are no good for my purposes
15 because they may well be antioxidants, but they are not apparently suitable
16 for preventing or inhibiting oxidation within the skin.

17 JUDGE LEOVITZ: Right. But Suzuki at column 5 does teach
18 alpha glycosol rutin, right? So even if Evans doesn't teach that compound in
19 a sunscreen, it turns out that Suzuki at column 5 does. So I think you've got
20 the teaching of using that compound in the prior art. And then you can rely
21 on Evans or maybe putting in some other antioxidants and for other
22 compounds, so even if the examiner may have confusingly described the
23 rejection, it does seem pretty clear that we have that compound in a
24 composition just as claimed except it's in Suzuki.

1 MR. MUENSTERER: Oh you mean it's obvious to add any further or
2 any 5, 10 other antioxidants to the composition of Evans. Is that what you
3 mean?

4 JUDGE LEBOVITZ: Well under KSR as long as you have a reason,
5 right?

6 MR. MUENSTERER: What would be the reason?

7 JUDGE LEBOVITZ: Well I'm saying we start out with Suzuki which
8 tells you that you want to use the alpha glycosol as an antioxidant and also
9 for its UV absorbing properties, so we actually have that teaching right
10 there.

11 MR. MUENSTERER: Well there are admittedly thousands of
12 compounds that you could use. I mean clearly the examiner used Suzuki
13 because she needed that for the combination. But you could have used
14 hundreds of other references that teach antioxidants for cosmetic
15 compounds. Of course she didn't because she knew she needed Suzuki.

16 JUDGE ADAMS: I think what I'm hearing you tell us is that the
17 antioxidants in Evans are very specific antioxidants, and they're selected
18 because they have a very particular activity.

19 MR. MUENSTERER: Yes.

20 JUDGE ADAMS: And then since we have these compounds, these
21 antioxidants selected for their very specific activity, why would one go to
22 any of a number of different antioxidants --

23 MR. MUENSTERER: In addition to --

24 JUDGE ADAMS: And merge it with Suzuki, when in fact it could be
25 incompatible, is that what you're saying?

1 MR. MUENSTERER: Well I'm not, not -- yeah, while incompatible
2 -- but Evans does teach additional or even recommend additional
3 antioxidants, namely those that stabilize these specific antioxidants that
4 Evans has found that not only protect components of cosmetic compositions,
5 but actually the skin. So we have no --

6 JUDGE ADAMS: Twofold activity: protect the other component in
7 addition to protecting the skin from the UV radiation.

8 MR. MUENSTERER: Plus what Evans says it's even better to add for
9 example in column 4, the diterpene antioxidants
10 -- they're the ones that are disclosed -- may be combined with ascorbic acid
11 or related compounds such as erythorbic acid and their alkali metal salts, to
12 provide a synergistic antioxidation effect.

13 JUDGE ADAMS: Well isn't ascorbic acid an antioxidant?

14 MR. MUENSTERER: Yeah.

15 JUDGE ADAMS: Would that be one of the compounds that Evans is
16 talking about, that we're saying have these two activities? First has the
17 activity of --

18 MR. MUENSTERER: No. Ascorbic acid -- in column 1 it basically
19 says, "These are all antioxidants that only protect the components of the
20 cosmetic composition."

21 JUDGE ADAMS: Right.

22 MR. MUENSTERER: And now we have found something that
23 doesn't. It's not even clear whether these compounds that are described here
24 are particularly good for protecting the components of the composition. But
25 apparently they are very good for protecting the skin. And they say it's even
26 better to have ascorbic acid or related compounds in there for the purpose

1 again of stabilizing a component of the cosmetic composition, namely the
2 antioxidants that protect the skin.

3 JUDGE ADAMS: Right. Well let me make sure I understand what
4 you're saying because Evans talks about ascorbic acid and Evans also talks
5 about these diterpene antioxidants.

6 MR. MUENSTERER: Mm hmm.

7 JUDGE ADAMS: And I believe it was the diterpene antioxidants that
8 you are focusing on initially saying that these are the new ones that Evans
9 discovered that have an effect on -- now let's be clear, what do these
10 particular antioxidants have an effect on? The skin or the components of the
11 composition or both?

12 MR. MUENSTERER: It says in column 2 line 43, "As demonstrated
13 herein these pure compounds are extremely effective in protecting the skin
14 from peroxidation when applied topically."

15 JUDGE ADAMS: Okay. So they only have one activity. See I was -
16 -

17 MR. MUENSTERER: Yeah. And then it says, "furthermore the
18 documented synergism with ascorbate has been shown by the inventors to be
19 a direct result of the protection afforded by ascorbate to the compound --

20 JUDGE ADAMS: Right, so ascorbic acid protects the components of
21 the composition, and then the diterpene antioxidants, a separate category,
22 would have the effect on skin.

23 MR. MUENSTERER: Mm hmm.

24 JUDGE ADAMS: Right. So we have these diterpene antioxidants.
25 And we also have the alpha glycosol rutin antioxidants taught by Suzuki.
26 And they both have this effect on skin. They both have this effect of

1 protecting against UVB radiation. And then we can even throw in ascorbic
2 acid into the mix because it's going to protect the components in this
3 composition, this sunscreen lotion that's taught by both Evans and Suzuki.
4 There's your reason.

5 MR. MUENSTERER: Well of course you can always find a reason.
6 For example Suzuki also says that these compounds are yellow coloring
7 agents and skin whitening agents. They are everything.

8 JUDGE ADAMS: But is it an antioxidant that can be used in a
9 sunscreen lotion? It's a yellow coloring. It can be used for all these different
10 things. Antioxidants have a whole bunch of properties.

11 MR. MUENSTERER: Of course it is a member of the huge list of
12 antioxidants that may not even all work by the same mechanism that you can
13 put into a sunscreen. But the question here is, Evans already has one
14 antioxidant that at least protects the skin, probably -- we don't know -- also
15 the cosmetic, the components of the composition --

16 JUDGE ADAMS: Well that's ascorbic acid --

17 MR. MUENSTERER: And the ascorbic acid. And then of course
18 you are free to add five or even more antioxidants of course.

19 JUDGE ADAMS: I agree.

20 MR. MUENSTERER: Yeah. And if that's obvious then it's obvious.
21 Of course you can find hundreds of documents that describe antioxidants --

22 JUDGE ADAMS: Why wouldn't it be obvious, in this Evans
23 situation, why wouldn't it be obvious -- since we've resolved that we have
24 these diterpenes that are useful in sunscreens, why wouldn't it be obvious to
25 make the modification of Evans with Suzuki to substitute the diterpene with
26 alpha glycosol rutin?

1 MR. MUENSTERER: How do you know that the alpha glycosol
2 rutin would serve the same purpose to protect the skin from --

3 JUDGE ADAMS: Against UVB radiation?

4 MR. MUENSTERER: No. Protect the skin from oxidation.

5 JUDGE ADAMS: Well isn't alpha glycosol rutin an antioxidant?

6 MR. MUENSTERER: But doesn't Evans not say that each and every
7 antioxidant protects the skin? Otherwise there would be no reason to have
8 these special antioxidants. There are plenty of antioxidants out there. So
9 why would you -- there's no indication in Suzuki that, although alpha
10 glycosol rutin maybe an antioxidant, it will protect the skin. It is just one of
11 the antioxidants, as far as I understand, that protects the components. I have
12 not found anything in there that says it protects the skin.

13 Let me because I'm running out of time --

14 JUDGE ADAMS: In Suzuki? In Suzuki you said?

15 MR. MUENSTERER: Yeah. From oxidation. It protects the skin
16 from UVB radiation, maybe as a sunscreen.

17 JUDGE ADAMS: As a sunscreen?

18 MR. MUENSTERER: Yeah.

19 JUDGE ADAMS: Can I direct your attention to column 18 of Suzuki.

20 MR. MUENSTERER: Yeah.

21 JUDGE ADAMS: Line, what is that 14 or 15?

22 MR. MUENSTERER: Mm hmm.

23 JUDGE ADAMS: The product is anti-oxidative, highly stable, and
24 favorably usable as a high-quality sunscreen.

25 MR. MUENSTERER: What does that tell me?

1 JUDGE ADAMS: Well and you just asked me to show you where
2 Suzuki would say use an antioxidant as a sun screening. Or did I
3 misunderstand the question?

4 MR. MUENSTERER: Well do you mean that oxidative means
5 protecting the skin from oxidation?

6 JUDGE ADAMS: I see what you're saying. What you're saying to
7 me is you don't know whether Suzuki is talking about protecting the
8 components in the composition, or protecting the skin. Is that what you're
9 saying?

10 MR. MUENSTERER: Yeah.

11 JUDGE ADAMS: Okay.

12 MR. MUENSTERER: From oxidation. It's a sunscreen. I have to
13 admit that because it says a sunscreen. But sunscreen doesn't mean that it is
14 anti-oxidative or protects the skin from oxidation.

15 But there is one other thing that I really need to address too. Let's
16 assume that the examiner properly came to the conclusion that a
17 combination of Evans and Suzuki renders obvious a composition that can be
18 used for skin that is to be exposed to UVB radiation and can contains
19 glycosol rutin in addition to all the others. Then the examiner says, well if
20 you apply it -- basically that's the argument -- you inherently protect or
21 suppress or treat or modulate immuno-suppression. Because it is known that
22 UVB radiation may have an effect on inducing suppressive T-lymphocytes,
23 which suppress the immune system. So it's inherently -- even if you don't
24 know it -- it's inherently practiced. Let's be clear about it. We are not
25 talking about a composition claim here. We are talking about a method
26 claim.

1 JUDGE MCCOLLUM: Is that argued in the brief? in terms of claim
2 37, do you argue --

3 MR. MUENSTERER: Yeah well I talk about inherent, but the
4 examiner apparently -- what occurred to me now is what the examiner does
5 not understand is that in this case, at least in my opinion, the same principles
6 alike with inherent anticipation have to be applied. Namely it must be
7 necessarily present for example, what the MPEP says quoting from --

8 JUDGE LEOVITZ: Well why wouldn't under Woodruff? It seems
9 that prior art would teach putting this on the skin --

10 MR. MUENSTERER: Yeah.

11 JUDGE LEOVITZ: Or suggest putting it on the skin so if you
12 happen to modulate immuno-suppression, which because you're using the
13 same compound, it would be reasonable to conclude that you would get
14 immuno-suppression.

15 MR. MUENSTERER: Yeah. No. No. I'm not arguing that. Who
16 would recognize it?

17 JUDGE LEOVITZ: It doesn't need to be recognized.

18 MR. MUENSTERER: It has to be recognized. For example, for
19 inherent anticipation at least it has to be recognized. That's what it says *in re*
20 *Roberts*. In items citing from the MPEP, the most recent addition, "To
21 establish inherency the extrinsic evidence 'must make clear that the missing
22 descriptive matter is necessarily', which we don't even know, 'present in the
23 thing described in the reference, and that it would be so recognized by
24 persons of ordinary skill.'"

25 JUDGE LEOVITZ: Well I think what that -- I think under
26 *Perricone* -- I think what it means is not that it was recognized in the prior

1 art but that the effect occurs, and people of skill in the art today would
2 realize that that's what was happening. So for example in Perricone's case as
3 long as it taught putting it on the skin you carried out the steps of the
4 method. Now they may not have recognized at the time that you were
5 protecting the skin from the UV effects, but that wasn't necessary to meet
6 anticipation. When they mean recognized, it means basically later on you
7 can prove that that was really what's happening.

8 MR. MUENSTERER: Yeah. Yeah.
9 I've seen that quote, and it's confusing, but that's what it means.

10 MR. MUENSTERER: But here we are not even talking about
11 anticipation. We are talking about obviousness. I mean that's even further
12 remote from the situation.

13 JUDGE MCCOLLUM: But the examiner is saying it's inherent in
14 what is obvious.

15 MR. MUENSTERER: And necessarily? The examiner says it's
16 likely. That people who apply this theoretical composition --

17 JUDGE MCCOLLUM: Can you point to where this was argued in
18 the brief please?

19 MR. MUENSTERER: What?

20 JUDGE MCCOLLUM: Where this argument was made in the brief.

21 MR. MUENSTERER: I'm not sure whether I spelled it out expressly.
22 I've argued it already in several other responses to two office actions, but
23 what I mentioned definitely was that the examiner apparently talks about
24 inherency here.

25 JUDGE LEBOVITZ: On page 7 I see the examiner -- something -- I
26 see inherent effect treating --

1 MR. MUENSTERER: Yeah, at the end of the first paragraph. But the
2 examiner also says it's likely, yes?

3 So if you apply the same principles for inherent anticipation and inherent
4 anticipation by an allegedly rendered obvious method, then you would also
5 have to apply the necessarily standard. In my opinion.

6 JUDGE ADAMS: Is there anything else that you wanted to
7 emphasize for us?

8 MR. MUENSTERER: Well I think my time is up. No I think that has
9 to be it.

10 JUDGE ADAMS: Any further questions? Thank you very much for
11 your time.

12 MR. MUENSTERER: Thank you for listening.

13 (Whereupon at 2:23 p.m. the proceedings were concluded)
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